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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 525,998	03-15-2000	Rudolph Hauptmann	98.385-E	1361

20306 7590 03-13-2002

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EXAMINER

O HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 03/13/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/525,998

Applicant(s)

HAUPTMANN ET AL.

Examiner

Eileen B. O'Hara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-21 and 24-148 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 19-21 and 24-148 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 19-21 and 24-148 are pending in the instant application. Claims 1-18 and 22-23 have been canceled, and claims 27-148 have been added as requested by Applicant in Paper Number 8, filed July 2, 2001.

Claims 27-39 and 41-61 have been amended as requested by Applicant in Paper Number 12, filed January 7, 2002.

### ***Election/Restrictions***

2. Applicant's election of Group I in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 19-21 and 24-26 are withdrawn as being drawn to a non-elected invention.

### **Restriction Requirement:**

3. Applicants claims are drawn to numerous patentably distinct nucleic acid sequences , Upon further consideration, further restriction *within* the formerly presented Invention I is required, as follows:

The claims are drawn to numerous patentably distinct nucleic acids, each of which constitutes a patentably distinct product. Applicant is required to elect a single invention of a nucleic acid, selected from the group consisting of:(i.e. elect one from the following Markush group):

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- A) a nucleic acid comprising polynucleotides of SEQ ID NOS: 1 and 3 encoding polypeptides comprising the sequences of SEQ ID NOS: 2 and 4, or
- B) a nucleic acid molecule of SEQ ID NO: 5 encoding a polypeptide of SEQ ID NO: 6, or
- C) a nucleic acid molecule of SEQ ID NO: 7 encoding a polypeptide of SEQ ID NO: 8, or
- D) a nucleic acid molecule of SEQ ID NO: 9 encoding a polypeptide of SEQ ID NO: 10, or
- E) a nucleic acid molecule of SEQ ID NO: 11 encoding a polypeptide of SEQ ID NO: 12, or
- F) a nucleic acid molecule of SEQ ID NO: 13 encoding a polypeptide of SEQ ID NO: 14, or
- G) a nucleic acid molecule of SEQ ID NO: 15 encoding a polypeptide of SEQ ID NO: 16, or
- H) a nucleic acid molecule of SEQ ID NO: 17 encoding a polypeptide of SEQ ID NO: 18, or
- I) a nucleic acid molecule of SEQ ID NO: 19 encoding a polypeptide of SEQ ID NO: 20.

Applicants should note that in some cases multiple claims encompass one of the patentably distinct inventions set forth herein, for example it is presumed by the Examiner.

To be fully responsive to this requirement, Applicants are **required** to point out which claims correspond to the elected invention.

Although the classifications for these various nucleic acids are overlapping, for instance 536/23.1, each represents a patentably distinct product with distinct physical and functional characteristics. Further the search for more than one product would be burdensome, because each is claimed not only by nucleic acid sequence, but by the sequence of the protein encoded thereby, and requires a search of the corresponding region of the nucleic acid sequence as well as a 'reverse translation' search of the corresponding region of the polypeptide sequences, such that each individual sequence requires two sequence searches which are not required for any of the

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other sequences. Searching all of the sequences in a single patent application would provide an undue search burden on the examiner and the USPTO's resources because of the non-coextensive nature of these searches. Accordingly, restriction is proper.

**In order to be fully responsive, Applicant must select one from the above Markush group. Applicant is advised that this is not a species election, it is a restriction requirement.**

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

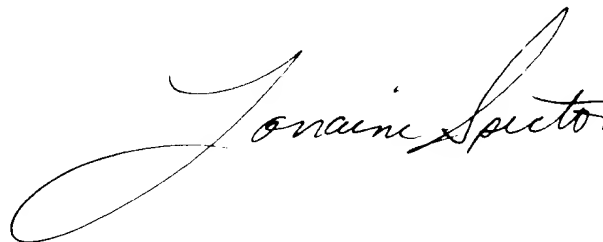
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Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

A handwritten signature in cursive script, reading "Lorraine Spector". The signature is written in dark ink and is positioned to the right of the typed name.

Patent Examiner

LORRAINE SPECTOR  
PRIMARY EXAMINER